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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,269	03/05/2002	Tadahiro Ohmi	FUK-84	2418

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EXAMINER	
CHEVALIER, ALICIA ANN	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/889,269	OHMI ET AL.
	Examiner	Art Unit
	Alicia Chevalier	1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 2* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 2* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

RESPONSE TO AMENDMENT

1. Claims 1 and 2 are pending in the application. Claims 3 and 4 were cancelled in the response, filed December 1, 2003.

2. Amendments to claims, filed on December 1, 2003, have been entered in the above-identified application.

WITHDRAWN REJECTIONS

3. The objection to claim 1, made of record in paper #9, mailed August 25, 2003, page 2, paragraph #2 has been withdrawn due to Applicant's amendment in the response, filed December 1, 2003.

REJECTIONS REPEATED

4. The 35 U.S.C. §102 rejection of claim 1 over Ohmi (US Patent No. 5,656,099) is repeated for reasons previously made of record in paper #9, pages 2-3, paragraph #4.

Ohmi discloses a metallic material (stainless steel) provided with a chromium oxide passivation film comprising a passivation film consisting of chromium oxide on the metallic material (col. 2, lines 33-45). The metallic material has a surface roughness of 0.1 micron (0.1 μm) or less (col. 3, line 65 to col. 4, line 5).

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim,

the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation "obtained by oxidizing a chromium coat on the metallic material" – claim 1 is a method of production and therefore does not determine the patentability of the product itself.

5. The 35 U.S.C. §103 rejection of claims 1 and 2 as over Uchida et al. (US Patent No. 4,248,676) in view of Ohmi (US Patent No. 5,656,099) is repeated for reasons previously made of record in paper #9, pages 3-5, paragraph #6.

Uchida discloses a steel plate (metallic material) that is passivated and made corrosion resistant (col. 3, lines 28-56) with a chromium layer (passivation film) having pin holes which are filled in with chromate (figure 5, col. 6, lines 14-29). The steel plate has a surface roughness of 0.8-3 microns (0.8-3 μm) (col. 10, lines 63-65).

Uchida discloses all the limitations of the instant claimed invention except that the passivation film is chromium oxide.

Ohmi discloses a metallic material (stainless steel) provided with a chromium oxide passivation film comprising a passivation film consisting of chromium oxide on the metallic material (col. 2, lines 33-45). The metallic material has a surface roughness of 0.1 micron (0.1 μm) or less (col. 3, line 65 to col. 4, line 5). Ohmi further discloses that the improved corrosion resistant properties have been obtained through the use of passivation films consisting of chromium oxide (col. 2, lines 24-38).

It would have been obvious to one of ordinary skill in the art to use a chromium oxide as the passivation film in Uchida as taught by Ohmi because of the improved corrosion resistance gained by layer consisting only of chromium oxide.

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation "obtained by oxidizing a

chromium coat on the metallic material" – claim 1 is a method of production and therefore does not determine the patentability of the product itself.

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments in the response, filed December 1, 2003, regarding the objection to claim 1 of record have been considered but is moot since the objection have been withdrawn.

7. Applicant's arguments in the response, filed December 1, 2003, regarding the 35 U.S.C. § 102 rejection over Ohmi of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the chromium oxide layer of Ohmi is made via a different process and therefore ***inherently*** differs from a chromium oxide layer produced via oxidation performed chromium layer on a stainless steel base, as in the case with the present invention. First, the limitation "oxidation performed chromium layer on a ***stainless steel base***," is not in the instant claims. Second, there is no evidence of record showing that the prior art of record is ~~inherently~~ different from the instant claimed invention. When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim which contains process limitations, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art, MPEP § 2113. Furthermore, the arguments of counsel cannot take the place of evidence in the record. See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration, MPEP § 2145.

In response to Applicant's arguments that the contour of the layer formed by Ohmi cannot be expected to be the same as in the instant claims, there are no limitations in the instant claims directed to the contour of the layer. Also, as stated above, Applicant has not provided evidence to support ~~their~~ this statement.

8. Applicant's arguments in the response, filed December 1, 2003, regarding the 35 U.S.C. § 103 rejection over Uchida in view of Ohmi of record have been carefully considered but are deemed unpersuasive.

Applicant argues that modifying Uchida to have a passivation layer of chromium oxide would render the invention of Uchida unsatisfactory for its intended purpose. Specifically, that a combination of a metal chromium layer in conjunction with a chromate film would not ~~longer~~ be used to provide corrosion resistance for a steel plate. Furthermore, such a change would definitely change the principle of operation of the base reference, i.e. the metallic chromium film enhances the adherence between the chromate film and the steel surface.

While ~~the~~ Uchida does disclose that adherence between the steel surface and the chromate film, a trivalent chromium oxide, is unsatisfactory (*col. 3, line 15-21*), The chromium film is use for it corrosion resistant properties and to help provide better adherence of the chromate film to the steel surface (*col. 3, line 57 through col. 4, line 19*). There is nothing in Uchida that teaches away from using another, non-trivalent chromium oxide as the chromium film.

As stated in the previous office action one of ordinary skill in the art would have been motivated to use Ohmi's chromium oxide film as Uchida's passivation film because of the

improved corrosion resistant properties have been obtained through the use of passivation films consisting of chromium oxide (*Ohmi col. 2, lines 24-38*).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (571) 272-1498. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (571) 272-0987.

ac
1/30/04

SANDRA M. NOLAN
PRIMARY EXAMINER